REMARKS

Claims 1-10 remain in this application. Claims 1-6 are rejected. Claims 7-10 are objected to. Claims 1, 3, 5 are amended herein to clarify the invention. Claims 7-10 are amended herein to stand in independent form.

Claims 1 and 2 are rejected under 35 U.S.C. §103(a) as obvious over the Fig. 4 art. The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness has not been established in the rejection of claims 1 and 2. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d

488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

In making the rejection of claim 1 based on the Fig. 4 art, the Examiner states the following:

> Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (Fig. 4). Admitted Prior Art discloses a magnetic transfer apparatus including members for performing magnetic transfer of signals from one medium to another, comprising:
>
> A base plate on which the members are placed (Fig. 4);
>
> A casing on the plate covering the members entirely (Fig. 4, Element 10);
>
> And a plurality of particle measurement device fixed in the base plate (Fig. 4, Element 16. Admitted Prior Art teaches one particle device being used in the base plate. It is known to use more than one to make a plurality and more specific measurements in the medium.).

From the above rejection it appears the Examiner has again misinterpreted the art of Fig. 4. The statement that the art shows a " particle measurement device fixed in the base plate (Fig. 4, Element 16. Admitted Prior Art teaches one particle device being used in the base plate. It is known to use more than one to make a plurality and more specific measurements in the medium.)" is clearly incorrect in that the device in Fig. 4 merely shows a suction hose being inserted through a door of the apparatus. As such, the suction hose is not *fixed* in the base plate. As stated in the specification with reference to Fig. 4, "a probe is inserted into the casing

10 through a door 10a for measuring the cleanliness inside the casing." No mention is made of fixing a plurality of probes in a base.

Furthermore, and of greater significance, the Fig. 4 art fails to show:

> a plurality of particle measurement devices having suction ports fixed in dispersed positions in the base plate such that dispersion characteristics of contaminants is determinable with the casing entirely enclosing the members.

In particular, the claim requires that the suction ports of the particle measurement devices be fixed in *dispersed* positions. Such a distribution permits the dispersion of the contaminants to be evaluated and a source of the contaminants determined based on the dispersion of the particle contaminants. The Examiner's statement that it "is known to use more than one to make a plurality and more specific measurements in the medium" is not supported by any cited art. Indeed that Fig. 4 art and the Sugimoto reference both show using only one sensors in the apparatus. Still further, nothing suggests dispersing the sensors as claimed. This is a structural characteristic which must be shown or suggested by the prior art in order for obviousness to be found. As noted above, each feature must be taught by the art. Therefore, should the Examiner continue to make the above assertion, it is requested that the Examiner provide prior art documentary support.

The Examiner, apparently in view of the above deficiency in the rejection, then goes on to state:

> Admitted Prior Art fail to teach a plurality of particle measurement devices in the base plate. It would have been obvious to a person of ordinary skill in the art to add a plurality of particle of particle measurement devices in order to monitor the particles found in the base plate. Although the reference did not disclose a plurality of detectors, the detectors are merely a duplication of parts and/or functions, which have little patentable significance unless a new and unexpected result is produced. See In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

The above cited case puts forth a *per se* rule for patentability, i.e., duplication of parts is unpatentable. However, application of such rules has been held legally insufficient for a rejection based on obviousness. *In re Ochiai* 37 USPQ2d 1127 (CA FC 1995) (Copy attached). In *Ochiai*, the court unambiguously stated the following:

> The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist

> derive from an impermissible effort to extract per se rules from decisions that disavow precisely such extraction. *In re Ochiai* 37 USPQ2d 1127 at 1133.

In *Ochiai*, the Examiner applied the *per se* rule that " that a process claim is obvious if the prior art references disclose the same general process using "similar" starting materials." *In re Ochiai* 37 USPQ2d 1127 at 1132. Since, this rule obviated the required steps of showing a suggestion for the modification in the art it did not comply with the standards for establishing obviousness. Likewise, the Examiner's application of the mere duplication of parts analysis is similarly defective. Nothing in the art presented suggests the multiple particle measurement devices claimed. The Examiner's attention is further directed to the recently decided case of *Ex parte Granneman*, 68 USPQ2d 1219 (BdPatApp&Int 2003) (Unpublished). Although non precedential, the Board is clearly following the holding of Ochiai which bars application of *per se* rules for obviousness in finding that the mere duplication of parts analysis is a *per se* rule and hence insufficient by itself to base an obviousness rejection on. Accordingly, it is respectfully submitted that obviousness of claim 1 has not been established.

Applicant further directs the Examiner's attention to the fact the particle measurement devices are claimed as being dispersed in a manner which allows the dispersion characteristics of contaminants to be determined which, in turn, allows the source to be determined. This provides a new and unexpected result in that

attention can be focused on the source of contaminants quickly and efficiently. Nothing in the art suggests the dispersal of measurement devices or finding sources of contaminants as done by the present invention.

Similarly, claim 2 is patentable for the reasons indicated above for claim 1 and for the further teaching of the placing the detector ports near respective operating members. Since multiple measurement devices are not taught, the dispersal near the operating members cannot be taught.

Thus, it is respectfully submitted that the rejected claims 1 and 2 are not obvious in view of the cited reference for the reasons stated above. Reconsideration of the rejections of claims 1 and 2 and their allowance are respectfully requested.

Claims 3-6 are rejected under 35 U.S.C. §103(a) as obvious over the Fig. 4 art in view of the Sugimoto reference. Again, it is respectfully submitted that Sugimoto reference provides no more relevant teachings than the Fig. 4 art. The Sugimoto reference merely details features of a particle counter and that the counter can verify the dust particle count when the pressure gradient is disturbed. In the Sugimoto reference, a single detector port is used. No mention is made of contaminant source detection which is made possible by the presently claimed invention Claim 5 is clearly distinguishable for reciting the plurality of measurement devices at dispersed locations as are dependent claims 3, 4 and 6.

Thus, it is respectfully submitted that the rejected claims 3-6 are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 3-6 and their allowance are respectfully requested.

Claims 7-10 are objected to as being dependent from rejected base claims. The Examiner indicates that the claims contain allowable subject matter and would be allowed if put in independent form incorporating the limitations of the base and intervening claims. The claims are amended in accordance with the Examiner's suggestion. Reconsideration of the objection and allowance of the claims are respectfully requested.

Three independent claims in excess of three are added. Accordingly, please charge the fee of $258.00 to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
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enc: Copies of *In re Ochiai* 37 USPQ2d 1127 (CA FC 1995) and *Ex parte Granneman*, 68 USPQ2d 1219 (BdPatApp&Int 2003).